

RECEIVED
CENTRAL FAX CENTERApplication No. 09/637,774
Amendment dated January 11, 2007

JAN 11 2007

Docket No.: 42982C1C(47843)

REMARKS

Claims 25-27, 29-34, 36-41, 43-47, and 49-50 are pending in the subject application. Claims 28, 35, 42, 48, and 51-59 stand canceled. Claim 25 has been amended to correct a typographical error. No new matter is presented by virtue of this amendment.

Amendment of any claim herein is not to be construed as acquiescence to any of the rejections/objections set forth in the instant Office Action, and was done to expedite prosecution of the application. Applicants make these amendments without prejudice to pursuing the original subject matter of this application in a later filed application claiming benefit of the instant application, including without prejudice to any determination of equivalents of the claimed subject matter. Favorable reconsideration of the present application is respectfully requested in light of the amendments and remarks which follow.

Claims 25-27, 29-31, 32-34, 36-41, 43-47, and 49-50 remain rejected under 35 U.S.C. §103(a) over *Weber et al.* (US 5,190,976), in view of *Durant et al.* (US 6,013,675 and US 6,153,604). It is alleged that Weber discloses positional isomers of compounds utilized in the instant invention, and that it would have been obvious to one of ordinary skill in the art to combine the teachings of Weber with Durant to arrive at the compounds utilized in the claimed invention.

Applicants disagree and respectfully traverse.

It is well established that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F. 2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F. 2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See, e.g., MPEP 2143.01.

At the outset, Applicants note that the instant claims are drawn to methods using guanidine compounds disclosed in US 6,787,569, and that the method claims of the instant invention have been amended to be commensurate with the scope of the compounds of US 6,787,569.

Application No. 09/637,774
Amendment dated January 11, 2007

Docket No.: 42982C1C(47843)

Weber discloses guanidine compounds of the formula $(R)NH-C(NH)-NH(R')$, wherein the R and R' groups are non-hydrogen substituents. The Weber teachings are therefore distinct from the instant invention as the instant invention is directed towards methods of treating disorders using guanidine compounds wherein only one nitrogen is di-substituted.

The Durant citations disclose a generic formula of mono-, di-, tri-, and tetra-substituted guanidines that do not teach or suggest the compounds of the instant invention.

Specifically, Durant '604 teaches certain tri-substituted guanidines and N,N'-disubstituted guanidines, wherein both the N and N' position are preferentially substituted with aryl groups. The N,N'-disubstituted compounds have non-hydrogen substituents on different nitrogens. Durant '604 does not teach or suggest guanidine compounds that are di-substituted at the same nitrogen. Durant '675 teaches various di- and tri-substituted guanidines, wherein the non-hydrogen di-substituted groups are on different nitrogens. Durant '675 does not teach or suggest di-substituted guanidine compounds that are di-substituted at the same nitrogen. The Durant compounds are distinct and distinguishable from Applicants' claimed compounds wherein the guanidine compounds are di-substituted at the same nitrogen. Because neither Weber nor the Durant references provides an express teaching or motivation to provide a di-substituted guanidine that is di-substituted on the same nitrogen, Weber and Durant fail to provide the necessary motivation or reasonable expectation of success to arrive at a guanidine that will meet the substitution pattern of Applicants' claims. Thus, the instant claims are not rendered obvious in view of Weber, Durant '604, or Durant '675.

Additionally, Applicants submit that Weber, Durant '604, and Durant '675, whether alone or in combination, actually teach away from the present invention. Neither Weber nor Durant provides exemplification of a guanidine compound that meets the criteria of Applicants' claims. The examples provided by Weber are directed to di-substituted guanidines of formula $(R)NH-C(NH)-NH(R')$. Of the 86 specifically delineated species in Weber, none have Applicants' primary amine $(-C(NH)-NH_2)$ moiety. The examples provided by the Durant references are directed to di-substituted guanidines of formula $(R)NH-C(NH)-NH(R')$, and tri-substituted guanidines of formula $(R)NH-C(NH)-N(R'')(R''')$. Of the 173 and 56 specifically delineated species in Durant '604 and '675, respectively, none have Applicants' $-C(NH)-NH_2$ moiety.

Application No. 09/637,774
Amendment dated January 11, 2007

Docket No.: 42982C1C(47843)

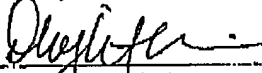
As provided above, the references cited, alone or in combination, include no such teaching, suggestion or motivation, and one of ordinary skill in the art would not have a reasonable expectation of success to make the modifications suggested by the Examiner. Additionally, the above references teach away from the instant invention by exemplifying compounds that do not satisfy the substitution pattern of the guanidines of the instant invention.

In view of the above, reconsideration and withdrawal of all rejections and allowance of claims 25-27, 29-34, 36-41, 43-47, and 49-50 are respectfully solicited. Accordingly, the Examiner is respectfully requested to pass this application to issue. Should any of the claims not be found to be allowable, the Examiner is requested to telephone Applicants' undersigned representative at the number below. Applicants thank the Examiner in advance for this courtesy.

The Director is hereby authorized to charge or credit any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 04-1105, under Attorney Docket No. 42982C1C (47843), Customer No. 21874.

Dated: January 11, 2007

Respectfully submitted,

By: 
Dwight D. Kim, Ph.D.
Registration No.: 57,665
Christine C. O'Day
Registration No.: 38,256
EDWARDS ANGELL PALMER &
DODGE LLP
P.O. Box 55874
Boston, Massachusetts 02205
Tel.: (617) 439-4444
Fax: (617) 439-4170
Attorneys/Agents For Applicant